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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: Gary M. KATZ

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SERIAL NO: 09/776,714

FILED: February 6, 2001

EXAMINER: ALVAREZ

GROUP ART UNIT: 3622

FOR: Method and System for Timing Promotions Based on a Prior Receipt of Promotions

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 41.37 APPEAL BRIEF

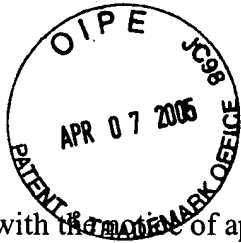
Sir:

In response to the final office action mailed January 7, 2005, the applicants appeal.

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I. **37 CFR 41.37 (a)**

This brief is filed with the notice of appeal under 41.31 and is accompanied by the fee set forth in 37 CFR 41.20(b)(2), and sets forth the authorities and arguments on which the appellant will rely to maintain the appeal.

II. **37 CFR 41.37 (b)**

The filing is timely. Accordingly, this subsection is not relevant.

III. **37 CFR 41.37 (c)(1)**

A. **37 CFR 41.37 (c)(1)(i) Real Party In Interest**

The real party in interest is Catalina Marketing International, Inc., a Delaware corporation, which is wholly owned by Catalina Marketing Corporation, a Florida corporation.

B. **37 CFR 41.37 (c)(1)(ii) Related Appeals And Interferences**

There are no related appeals or interferences. Accordingly, this section is inapplicable.

C. **37 CFR 41.37 (c)(1)(iii) Status Of Claims**

Claims 1-65 are pending. Claims 59-61 are withdrawn. Claims 1-58, and 62-65 are rejected and under appeal.

D. **37 CFR 41.37 (c)(1)(iv) Status Of Amendments**

All amendments are entered. A decision on a petition to reinstate withdrawn claims 59-61 filed January 13, 2005 is pending.

E. **37 CFR 41.37 (c)(1)(v) Summary Of Claimed Subject Matter**

The invention of claim 1 is a computer-implemented method comprising steps of: receiving identification information from a consumer (figure 1; page 8 line 30); identifying, based upon said received identification information, one or more parameters related to promotions received by said consumer (page 3 lines 28 to page 4 line 3; page 16 lines 4-15; page

19 lines 13-21); and determining a time at which a promotion is to be provided based upon said identified one or more parameters related to promotions received by said consumer (page 16 lines 4-15; page 19 lines 13-14).

The invention of claim 28 is a system, comprising: means for receiving identification information from a consumer (figure 1; page 8 line 30); means for identifying one or more parameters related to promotions received by said consumer based upon said identification information received by said means for receiving (page 3 lines 28 to page 4 line 3; page 16 lines 4-15; page 19 lines 13-21); and means for determining a time at which a promotion is to be provided based upon said one or more parameters related to promotions received by said consumer, said one or more parameters identified by said means for identifying (page 16 lines 4-15; page 19 lines 13-14).

The invention of claim 33 is a system, comprising: a consumer identification information receiver configured to receive consumer identification information (figure 1; page 8 line 30); a consumer identification record configured to contain stored consumer identification information (page 15 lines 17-30; figure 3B); a consumer characteristic record configured to contain a record of characteristics of said consumer (page 16 lines 3-6; figure 4A); a promotion output device configured to output a targeted promotion at a promotion time based at least in part upon said record of characteristics of said consumer (page 18 lines 21-28); and a processor configured to use said received consumer identification information to identify a consumer using said stored consumer identification information (page 18 lines 7-11), and moreover to determine said promotion time at least in part based upon said record of characteristics of said consumer contained in said consumer characteristic record (page 19 lines 8-13).

F. 37 CFR 41.37 (c)(1)(vi) Grounds Of Rejection To Be Reviewed On Appeal

Whether the rejections of claims 1-32 under 35 USC 101 as being directed to non-statutory subject matter are improper and should be reversed.

Whether the rejections of claims 1-5, 7, 9-21, 23-36, 39-42, 44-46, and 62-65 under 35 USC 102(e) as being anticipated by Swix et al. (USP 6,718,551 hereinafter “Swix”) are improper and should be reversed.

Whether the rejections of claims 6, 8, 22, 37, 38, 43, and 47-58 under 35 USC 103(a) as being unpatentable over Swix are improper and should be reversed.

G. 37 CFR 41.37 (c)(1)(vii) Argument

1. The Rejections Of Claims 1-32 Under 35 USC 101 Are Improper And Should Be Reversed

Claims 1-32 stand rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter. In support of the rejections, the examiner states that:

In the present application, independent claim 1 recite[s] a method and independent claim 28 recites a system (in “means plus function”) language. Method claim 1 clearly recites a “useful, concrete and tangible result” (“determining a time at which a promotion is to be provided to a consumer”), however the claim recites no structural limitations (i.e., computer implementation), and so it fails the first prong of the test (technological arts). System claim 28 also clearly recites a “useful, concrete and tangible result” however, since the claim is in “means plus function” language, the specification must be consulted to determine the corresponding structure and equivalents thereof:

The plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure. Paragraph six does not state or even suggest that the PTO is exempt from this mandate, and there is no legislative history indicating that Congress intended that the PTO should be. Thus, this court must accept the plain and precise language of paragraph six. In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994).

When one looks to the specification to determine the corresponding

structure, or equivalents thereof, for the “means” recited in claim 28, one finds the following. “The present invention, in certain preferred embodiments, provides a method for presenting a selected offer to the associated individuals (i.e. not necessarily computer implemented).”

From this it can be seen that the broadest reasonable equivalent disclosed (“by hand” or “manually transmission”) fails to pass the first prong technological arts test and therefore recites non-statutory subject matter under 35 USC 101. [Office action mailed January 7, 2005 page 5 line 12 - page 6 line 10.]

In response, the applicant points out that the examiner has misapplied the law respecting “technological arts.” In point of fact, claim 1 is specifically limited to a computer implemented method, reciting “A computer-implemented method....” Moreover, claims 28-32 are system claims, and therefore define subject matter clearly excluding operation by hand.

In addition, the examiner has made an improper factual assertion. The examiner asserts that claim 1 recites no structural limitations such as computer implementation. However, as pointed out in the previous paragraph, claim 1 is specifically limited to a computer implemented method.

Therefore, the examiner's conclusion that the “broadest reasonable interpretation ... [is a method performed] by hand ...,” is clearly incorrect. The term “by hand” in this context means without use of any technological aids, such as tools. Clearly, using a computer is not what is meant “by hand”. Accordingly, the “means for” recitations in claims 28-37 necessarily read on the computer related structure of the disclosed embodiments.

Furthermore, the applicant hereby disclaims any system functioning solely without use of a computer system; thus, claims 28-32 are clearly statutory. In addition, the specification contains no embodiment implemented “by hand.”

Moreover, the examiner's conclusion is clearly inconsistent with the Board of Patent Appeals and Interference's published decision, Ex parte Bowman, 2001 Pat App. Lexis 46 (BPAI June 12, 2001). Therein, the panel held that the technological arts test was only applicable if the specification and claims did not limit the claimed invention to being computer implemented,

stating in pertinent part that, emphasis of the pertinent passage added:

With respect to the rejection under 35 U.S.C. § 101, the examiner asserts that the claimed invention does not fall within the technological arts because no form of technology is disclosed or claimed [answer, page 3]. *** The examiner responds that ... appellant has not recited the use of a computer in either the specification or the claims. The examiner finds that neither the specification nor the claims discuss the use of any technology with respect to the claimed invention [answer, pages 5-6].

We agree with the examiner. Appellant has carefully avoided tying the disclosed and claimed invention to any technological art or environment. As noted by the examiner, the disclosed and claimed invention is directed to nothing more than a human making mental computations and manually plotting the results on a paper chart [answer, page 5]. The *Examination Guidelines for Computer-Related Inventions are not dispositive of this case because there is absolutely no indication on this record that the invention is connected to a computer in any manner. *** In summary, we find that the invention before us is nothing more than an abstract idea which is not tied to any technological art, environment, or machine, and is not a useful art as contemplated by the Constitution of the United States.* The physical aspects of claim 1, which are disclosed to be nothing more than a human manually drawing a chart and plotting points on this chart, do not automatically bring the claimed invention within the technological arts. For all the reasons just discussed, we sustain the examiner's rejection of the appealed claims under 35 U.S.C. § 101. [Ex parte Bowman, 2001 Pat. App. Lexis 46 (BPAI June 12, 2001).]

However, here claims 1-32 define, and the specification expressly discloses, computer implementation. Therefore, the claims define inventions within the technological arts and constitute patentable subject matter within the meaning of 35 USC 101. Thus, the rejections of

claims 1-32 based upon 35 USC 101 are improper and should be reversed.

2. The Rejections Of Claims 1-5, 7, 9-21, 23-36, 39-42, 44-46, And 62-65 Under 35 USC 102 As Being Anticipated By Swix et al. (USP 6,718,551) Are Improper And Should Be Reversed

a. Summary of the Applicant's Response to the Examiner's Reasoning and 35 USC 102 Rejections

In response, the applicant respectfully traverses these rejections because they are not supported by substantial evidence or valid reasoning.

First, Swix does not disclose determining a time at which a promotion is to be provided based upon said identified one or more parameters related to promotions received by said consumer, as defined by independent claims 1 and 28. This application discloses that parameters related to promotions are data defining the nature of promotions already received, the type of promotions already received, the class of promotions already received, the industry of promotions already received, the valid dates of promotions already received, the valid locations of promotions already received, the provision of promotions already received, the packaging of promotions already received, other products that must be purchased to exercise the promotions already received, the value of promotions already received, and/or the timing of promotions already received. See page 19 line 24 to page 20 line 3. Swix does not disclose how or whether to make determinations as to when to display an advertisement to a customer. Swix certainly does not disclose making such a time-to-display determination based upon the types of data defined by claims 1 and 28's parameters related to promotions. Therefore, the rejections of claims 1 and 28 are improper and should be reversed.

Second, the examiner has not presented a prima facie case for the 35 USC 102(e) rejections of claims 3, 7, 9-15, 19-21, 23-25, 27, 29-36, 39-42, 45-46, and 62-65. Thus, the rejections of claims 3, 7, 9-15, 19-21, 23-25, 27, 29-36, 39-42, 45-46, and 62-65 are improper and should be reversed.

Third, Swix does not disclose the limitations of dependent claims 2, 3, 7, 9-15, 19-21, 23-25, 27, 29-32, 34-36, 39-42, 45, 46, 63, and 65. Thus, the rejections of claims 2, 3, 7, 9-15, 19-

21, 23-25, 27, 29-32, 34-36, 39-42, 45, 46, 63, and 65 are improper and should be reversed.

Fourth, the rejections of claims 4, 5, and 17 are improper for at least the same reasons that the rejection of claim 1 is improper. Thus, the rejections of claims 4, 5, and 17 should be reversed.

Fifth, Swix does not disclose a step of selecting a targeted promotion from a plurality of potential promotions based upon said one or more characteristics of said consumer, said determined time being for said targeted promotion, as defined by claim 16. Swix does not disclose how or whether to make determinations as to when to display an advertisement to a customer. Swix certainly does not disclose making such a time-to-display based upon the types of data defined by claim 16. Thus, the rejection of claim 16 is improper and should be reversed.

Sixth, Swix does not disclose a method wherein a desired consumer profile originates from a promoter as defined by claim 18. While Swix teaches that a consumer profile originates from Swix's system, Swix does not disclose a system that provides promotions related to its own product, thus the system disclosed in Swix is not a promoter. Therefore, Swix does not teach that the consumer profile originates from a promoter. Therefore, the rejection of claim 18 is improper and should be reversed.

Seventh, Swix does not disclose a method or system including the step of determining a time at which said promotion is to be provided which comprises determining at least one of a demographic and a purchase history characteristic of said consumer, as defined by claims 26 and 44. The timing of when the advertisements are aired in Swix has nothing to do with the demographic and purchase history of the consumer. Rather, the advertisements in Swix are delivered when there is an open advertisement slot. Therefore, Swix does not disclose a method wherein said step of determining said time at which said promotion is to be provided comprises determining at least one of a demographic and a purchase history characteristic of said consumer, as defined by claims 26 and 44. Thus, the rejections of claims 26 and 44 should be reversed.

b. The Examiner's Reasoning for Rejections Of Claims 1-3, 7, 9-15, 19-21, 23-25, 27-36, 39-42, 45-46 And 62-65 Under 35 USC 102

In support of the 35 USC 102(e) rejections of claims 1-3, 7, 9-15, 19-21, 23-25, 27-36, 39-42, 45-46, and 62-65 the examiner stated that:

With respect to claims 1-3, 7, 9-15, 19-21, 23-25, 27-36, 39-42, 45-46, 62-65 Swiss [sic] teaches a computer implemented method (Abstract). Receiving identification information from a consumer (Figure 2, 210); identifying, based upon said received identification information, one or more parameters related to promotions received by said consumer (Figure 3, 302); determining a time at which promotions is [sic] to be provided based upon said identified one or more parameters related to promotions received by said consumer (col. 10, lines 52 to col. 11, lines 1-3). [Office Action mailed January 7, 2005 page 6 lines 20-26, interpolation supplied.]

In response to applicant's first response, the examiner clarified her reasons, stating that:

Applicant argues that Swiss [sic] doesn't teach determining a time at which a promotion is to be provided based upon said identifies one or more parameters related to promotions received by said consumer. The Examiner disagrees with Applicant because Swiss [sic] teaches determining a time, such as when the user is watching a particular program in which to present to present [sic] further ads, based on the user's receipt of previous ads. For example, when a user is [sic] has watched/received a commercial for outdoor adventure gear then the system determines when is the right time to display a commercial for a sport utility vehicle in which the user can carry out the adventure gear previously watched/received by the customer (col. 12, lines 43-60). [Office Action mailed 1/7/2005 page 9 line 17 to page 10 line 4; interpolation supplied.]

Column 10 line 52 to column 11 line 3 of Swix states that:

During this interactive session, the navigator records each subscriber selection as event data. In the preferred embodiment, the navigator uploads the latest event data to merge processor 100 every time a new targeted advertisement must be inserted. In this manner, profile processor 100 has the latest event data, along with the data from other databases, to assess a viewer's current interests. Thus, for example, in screen 302, the present invention could display a bit map or video movie trailer advertisement enticing the subscriber to look further into the menu options but not necessarily targeting a specific customer profile or demographic group. Then, once the subscriber has chosen "movies" and moved to screen 304, the present invention could display a bit map or video advertisement for popcorn knowing that this particular subscriber has watched several movies in the last month (from the event data) and that the subscriber indicated a liking for popcorn in a recent consumer spending survey (from survey database 126).
[Column 10 line 52 to column 11 line 3.]

Column 12 lines 43 to 60 of Swix, upon which the examiner relies upon in the response to argument section, states that:

...advertisement for outdoor adventure gear, then watched a movie trailer about a wilderness hiking disaster, and finally ordered the feature movie presentation about a wilderness survival competition.

According to the present invention, when the viewer orders the feature movie presentation, the pay-per-view service prepares to send the movie along with the commercials that will precede and follow the movie. At this point, profile processor 104 analyzes the event data and additional data, classifies the viewer in a certain demographic group, and delivers a commercial targeted for

that group. As an example, given the viewer's interest in outdoor adventures, a suitable advertisement would be a commercial for a sport utility vehicle with specialized accessories that carry outdoor adventure gear. The present invention would deliver this advertisement as a full screen video stream played prior to or after the showing of the feature movie presentation.

Broadcast Advertisement Insertion [Column 12 lines 43-60.]

**c. The Applicant's Response to the Examiner's 35 USC 102(e)
Rejections For Independent Claims 1 and 28**

In the office action mailed January 7, 2005 on page 6 lines 24-26, the examiner relied upon Swix column 10 line 52 to column 11 line 3 to support her assertion that "Swix teaches determining a time at which promotions is to be provided based upon said identified one or more parameters related to promotions received by said consumer." Clearly that assertion is wrong because Swix does not disclose determining a time to air these ads, in which that determined time is based upon parameters related to received promotions. Swix discloses airing the commercials when there is an open advertisement slot, like before or after a movie. See Swix column 9 lines 19-20 and column 12 lines 49-50. Nothing in Swix suggests determining when to display an advertisement to the consumer based upon parameters related to promotions received by that customer, such as the nature, the type, the class, the industry, the valid dates, the valid locations, the provision method, the packaging, the products that must be purchased to exercise the promotions already received, the value, and/or the timing of promotions already received. The examiner's reliance on Swix column 10 line 52 to column 11 line 3 is misplaced because that passages discloses a system which displays a video advertisement based upon event data and a consumer survey, not determining the time to display a promotion based upon parameters related to received promotions.

In the office action mailed January 7, 2005 on page 9 lines 20-22 the examiner further relied upon Swix column 12 lines 43-60 to support her assertion that "Swix teaches determining a time, such as when the user is watching a particular program in which to present further ads, based on the user's receipt of previous ads." Clearly that assertion is wrong because Swix does

not disclose determining a time to air these ads, in which that determined time is based upon parameters related to received promotions. Swix discloses airing the commercials when there is an open advertisement slot, like before or after a movie. See Swix column 9 lines 19-20 and column 12 lines 49-50. Nothing in Swix suggests determining when to display an advertisement to the consumer based upon parameters related to promotions received, such as the nature, the type, the class, the industry, the valid dates, the valid locations, the provision method, the packaging, other products that must be purchased to exercise the promotions already received, the value and/or the timing of promotions already received. The examiner's reliance on Swix column 12 lines 43-60 is misplaced because that passage discloses analyzing event and additional data, classifying the viewer in a certain demographic group, and delivering a commercial for that group before or after a movie, not determining a time to provide a promotion based upon parameters related to promotions received by a customer.

The examiner's specific reasoning supporting the assertion that Swix teaches determining a time is that "For example, when a user has watched/received a commercial for outdoor adventure gear then the system determines when is the right time to display a commercial for a sport utility vehicle in which the user can carry out the adventure gear previously watched/received by the customer." Office action mailed January 7, 2005 page 9 line 17 to page 10 line 4. That conclusion is wrong because Swix does not teach determining the right time to display a commercial, rather Swix teaches determining what commercial to display in an open advertisement slot, and depending that determination upon the demographic group in which Swix classified the consumer. See Swix column 9 lines 17-20. Swix cites as an example that if a viewer was interested in outdoor adventures, a suitable advertisement would be a commercial for a sport utility vehicle with specialized accessories that carry outdoor adventure gear. See column 12 lines 53-57. That example in Swix does not disclose timing the delivery of the advertisement. In fact, as mentioned supra, Swix teaches that the commercials are aired when there is an open advertisement slot. Airing a commercial when there is an open advertisement slot is not equivalent to determining a time to provide a promotion based upon identified parameters related to promotions received. The times when advertisement slots exist are determined by whoever sets up the programming. Swix does not concern itself with who schedules programming in a

standard video broadcast. Accordingly, Swix also does not disclose determining a time to provide a promotion based upon a parameter related to promotions received by consumer.

In summary, Swix does not disclose determining a time to provide a promotion, wherein the determined time is based upon identified parameters related to promotions received by the customer, as defined by claims 1 and 28. Therefore, the rejections of claims 1 and 28 are improper and should be reversed. Because claims 2-3, 7, 9-15, 19-21, 23-25, 27, 29-32, 46, and 62-65 depend either directly or indirectly from claims 1 and 28 the rejections of claims 2-3, 7, 9-15, 19-21, 23-25, 27, 29-32, and 62-65 are also improper and should be reversed.

**d. The Examiner Has Not Presented A Prima Facie Case For The
35 USC 102(e) Rejections Of Claims 3, 7, 9-15, 19-21, 23-25, 27,
29-36, 39-42, 45-46 And 62-65**

The examiner has not presented a prima facie case for the 35 USC 102(e) rejections of claims 3, 7, 9-15, 19-21, 23-25, 27, 29-36, 39-42, 45-46 and 62-65. Specifically, the examiner has made no remarks addressing any limitation defined by these claims. The examiner's remarks of record address only the limitations 1, 2, 4, 5, 16, 26, 28, and 44. See the office action mailed January 7, 2005 lines 20-26, and page 9 line 17 to page 10 line 20. The examiner (or the Board, if the Board is the first body to raise a particular ground for rejection) "bears the initial burden . . . of presenting a prima facie case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The applicant pointed out that the examiner did not present a prima facie case in the response filed October 7, 2004. In the final office action filed January 7, 2005; however, the examiner did not address the Applicant's remarks by presenting a prima facie case for claims 3, 7, 9-15, 19-21, 23-25, 27, 29-36, 39-42, and 45-46. Furthermore, the examiner now rejects claims 62-65 without presenting a prima facie case of anticipation. Thus, the examiner has not met the burden for showing a prima facie case of anticipation by Swix of claims 3, 7, 9-15, 19-21, 23-25, 27, 29-36, 39-42, 45-46, and 62-65. Therefore, the rejections of claims 3, 7, 9-15, 19-21, 23-25, 27, 29-36, 39-42, 45-46, and 62-65 should be reversed.

**e. Swix Does Not Disclose The Limitations Of Dependent Claims
2, 3, 7, 9-15, 19-21, 23-25, 27, 29-32, 34-36, 39-42, 45, 46, 63,
And 65 And Independent Claim 33**

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. Of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Each and every element of claims 2-3, 7, 9-15, 19-21, 23-25, 27, 29-36, 39-42, 45-46, 63 and 65 is not found, either expressly or inherently described, in Swix. Each claim is discussed below.

Swix does not disclose the recitation in claim 2 of “wherein said one or more parameters related to said promotions received by said consumer relate to a packaging of said received promotions received by said consumer.” The examiner states in the response to argument section that Swix relates the promotions to the nature of the received promotions. However, the nature of a promotion is not equivalent to the packaging of the received promotions. Therefore, the rejection of claim 2 is improper and should be reversed.

Swix does not disclose the recitation in claim 3 of “wherein said one or more parameters related to said promotions received by said consumer relate to a time at which said promotions received were received by said consumer.” Therefore, the rejection of claim 3 is improper and should be reversed.

Swix does not disclose the recitation in claim 7 of “wherein said one or more parameters related to said promotions received by said consumer relate to a value of said promotions received.” Therefore, the rejection of claim 7 is improper and should be reversed.

Swix does not disclose the recitation in claim 9 of “wherein said one or more parameters related to said promotions received by said consumer relate to a provision method of said promotions received.” Therefore, the rejection of claim 9 is improper and should be reversed.

Swix does not disclose the recitation in claim 10 of “wherein said one or more parameters related to said promotions received by said consumer relate to other purchases necessary to exercise said promotions received.” Therefore, the rejection of claim 10 is improper and should be reversed.

Swix does not disclose the recitation in claim 11 of “wherein said one or more parameters

related to said promotions received by said consumer relate to a nature of said promotions received.” Therefore, the rejection of claim 11 is improper and should be reversed.

Swix does not disclose the recitation in claim 12 of “wherein said one or more parameters related to said promotions received by said consumer relate to a promoter who is the source of said promotions received.” Therefore, the rejection of claim 12 is improper and should be reversed.

Swix does not disclose the recitation in claim 13 of “wherein said step of identifying one or more parameters comprises determining if said consumer is appropriate for said promotion, said promotion being predetermined.” Therefore, the rejection of claim 13 is improper and should be reversed.

Swix does not disclose the recitation in claim 14 of “further comprising a step of providing said promotion at said determined time to said identified consumer.” Therefore, the rejection of claim 14 is improper and should be reversed.

Swix does not disclose the recitation in claim 15 of “further comprising a step of using said received identification information to identify said consumer.” Therefore, the rejection of claim 15 is improper and should be reversed.

Swix does not disclose the recitation in claim 19 of “receiving a predetermined promotion from a promoter, said determined time being for said predetermined promotion.” Therefore, the rejection of claim 19 is improper and should be reversed.

Swix does not disclose the recitation in claim 20 of “wherein said step of determining said time at which said promotion is to be provided comprises determining a number of promotions recently received by said consumer.” Therefore, the rejection of claim 20 is improper and should be reversed.

Swix does not disclose the recitation in claim 21 of “wherein said number of promotions recently received by said consumer comprising promotions in a particular industry recently received by said consumer.” Therefore, the rejection of claim 21 is improper and should be reversed.

Swix does not disclose the recitation in claim 23 of “wherein said step of determining said time at which said promotion is to be provided comprises determining a value of said

promotions recently received by said consumer.” Therefore, the rejection of claim 23 is improper and should be reversed.

Swix does not disclose the recitation in claim 24 of “wherein said step of determining said time at which said promotion is to be provided comprises determining an importance of said provision of said promotion to a promoter.” Therefore, the rejection of claim 24 is improper and should be reversed.

Swix does not disclose the recitation in claim 25 of “charging a promoter according to said importance of said provision of said promotion.” Therefore, the rejection of claim 25 is improper and should be reversed.

Swix does not disclose the recitation in claim 27 of “determining promotions recently received by said consumer; determining at least one of a demographic and a purchase history characteristic of said consumer; determining an importance of said provision of said promotion to a promoter; and fusing said determined promotions recently received, said at least one of a demographic and a purchase history characteristic, and said importance of said provision into one parameter related to said time at which said promotion is to be provided.” Therefore, the rejection of claim 27 is improper and should be reversed.

Swix does not disclose the recitation in claim 29 of “wherein said one or more parameters of related to promotions received by said consumer comprising at least one of a timing, an industry, a class, a type, a packaging, a validity date, a valid location, other products that must be purchased to exercise, and a value of said promotions received by said consumer.” Therefore, the rejection of claim 29 is improper and should be reversed.

Swix does not disclose the recitation in claim 30 of “means for providing said promotion at said time determined by said means for determining to said consumer identified by said means for identifying.” Therefore, the rejection of claim 30 is improper and should be reversed.

Swix does not disclose the recitation in claim 31 of “means for selecting a targeted promotion from a plurality of potential promotions based upon said one or more characteristics of said consumer, said time determined by said means for determining being for said targeted promotion.” Therefore, the rejection of claim 31 is improper and should be reversed.

Swix does not disclose the recitation in claim 32 of “means for receiving a predetermined

promotion from a promoter, said time determined by said means for determining being for said predetermined promotion.” Therefore, the rejection of claim 32 is improper and should be reversed.

Swix does not disclose either the recitation in claim 33 of “a promotion output device configured to output a targeted promotion at a promotion time based at least in part upon said record characteristics of said consumer” or “a processor configured ...to determine said promotion time at least in part based upon said record or characteristics of said consumer contained in said consumer characteristic record.” Therefore, the rejection of claim 33 is improper and should be reversed. Furthermore, claims 34-36 and claim 45 depend from claim 33, so for the same reasons the rejection of claim 33 is improper, the rejections of claims 34-36 and 45 are improper. Thus, the rejections of claims 34-36 and 45 should be reversed.

Swix does not disclose the recitation in claim 34 of “said promotion output device comprises a network interface; and said promotion comprises an electronic signal.” Therefore, the rejection of claim 34 is improper and should be reversed.

Swix does not disclose the recitation in claim 35 of “a received promotions record configured to contain a record related to received promotions received by said consumer.” Therefore, the rejection of claim 35 is improper and should be reversed.

Swix does not disclose the recitation in claim 36 of “wherein said received promotions record comprises a received promotion value record.” Therefore, the rejection of claim 36 is improper and should be reversed.

Swix does not disclose the recitation in claim 39 of “wherein said received promotions record comprises a received promotion product class record.” Therefore, the rejection of claim 39 is improper and should be reversed.

Swix does not disclose the recitation in claim 40 of “wherein said received promotions record comprises a received promotion industry record.” Therefore, the rejection of claim 40 is improper and should be reversed.

Swix does not disclose the recitation in claim 41 of “wherein said received promotions record comprises a received promotion provision method record.” Therefore, the rejection of claim 41 is improper and should be reversed.

Swix does not disclose the recitation in claim 42 of “wherein said received promotions record comprises a received promotion packaging record.” Therefore, the rejection of claim 42 is improper and should be reversed.

Swix does not disclose the recitation in claim 45 of “a promotion receiver configured to receive a predetermined promotion from a promoter, said promotion time determined by said processor being for said predetermined promotion.” Therefore, the rejection of claim 45 is improper and should be reversed.

Swix does not disclose the recitation in claim 46 of “A computer readable medium containing program instructions for execution on a computer system, which when executed by the computer system, cause the computer system to perform the method recited in any one of claims 1 to 27.” Therefore, the rejection of claim 46 is improper and should be reversed.

Swix does not disclose the recitation of claim 63 “wherein said determining a time at which a promotion is to be provided based upon said identified one or more parameters related to promotions received by said consumer comprises determining in a computer system.” Therefore, the rejection of claim 63 is improper and should be reversed.

Swix does not disclose the recitation of claim 65 “wherein said means for determining a time at which a promotion is to be provided based upon said one or more parameters related to promotions received by said consumer, said one or more parameters identified by said means for identifying comprises means for determining by a digital processor.” Therefore, the rejection of claim 65 is improper and should be reversed.

**f. The 35 USC 102(e) Rejections Of Claims 4 and 5 Are Improper
And Should Be Reversed**

Claims 4 and 5 are rejected under 35 USC 102(e) as being anticipated by Swix. The examiner asserts that:

With respect to claims 4 5, Swix further teaches that one or more parameters related to said promotions received by said consumer relate to a product class/product industry of said promotions received by said consumer

(Figure 3). [Office Action mailed Jan. 7, 2005 page 7 lines 3-5.]

The examiner further states in the response to argument section:

Applicant argues that Swiss [sic] doesn't teach that the promotions received by the consumer related to a product class/product industry. The examiner disagrees with Applicant because based on the ads received by the customer, for example, outdoor gear, a related product is selected and displayed to the consumer (col. 10, lines 43-67). [Page 10 lines 9-12.]

In response, the applicant submits that the rejections of claims 4 and 5 are improper for at least the same reasons that the rejection of claim 1 is improper. Therefore the rejections of claims 4 and 5 are improper and should be reversed.

g. The 35 USC 102(e) Rejection Of Claim 16 Is Improper And Should be Reversed

Claim 16 is rejected under 35 USC 102(e) as being anticipated by Swix. In support of this rejection, the examiner states that:

With respect to claim 16, Swix further teaches selecting a targeted promotion from a plurality of potential promotions based upon said one or more characteristics of said consumer, said determined time being for said targeted promotion (col. 12, lines 22-90 [sic]). [Office Action mailed Jan. 7, 2005 page 7 lines 6-9; interpolation supplied.]

In the response to argument section, the examiner further states that:

Applicant argues that Swiss [sic] doesn't teach selecting said promotion based on characteristics of the customer. The Examiner disagrees with Applicant

because Swiss [sic] teaches using the event data of the customer to target the promotions (col. 10, lines 51- to col. 11, lines 1-2). [Office action mailed Jan. 7, 2005 page 10 lines 13-16.]

In reply, the applicant submits that at least for the reasons the rejection of claim 1 is improper, the rejection of claim 16 is improper.

Moreover, Swix does not disclose “a step of selecting a targeted promotion from a plurality of potential promotions based upon said one or more characteristics of said consumer, said determined time being for said targeted promotion,” as recited by claim 16.

The examiner cites to column 12 lines 22-60 and column 10 line 51 to column 11 line 2 of Swix for teaching that selecting a targeted promotion from a plurality of potential promotions based upon said one or more characteristics of a consumer.

Column 12 lines 22-60 of Swix states that:

An example of the video stream playlist method of the present invention is a pay-per-view movie service that shows commercials or movie trailers before and after a feature presentation. In this case, merge processor 100 would contain an event list of every viewing selection made by the subscriber up to the ordering of the movie. The event list could include data such as movie previews watched, movies watched, television programming watched, products ordered via interactive television, choices from interactive menus, commercials viewed, and commercials turned off. The historical extent of the data would depend on how long the present invention was active on the subscriber's television. In addition to event data, the media service provider would also have subscriber account information such as billing.

As the subscriber progresses through the pay-per-view menu screens, events (subscriber selections) are stored in the set-top box and periodically uploaded to the server. The server collects the data and organizes it into event lists. For example, the list may show that the viewer watched a movie trailer for a

movie about white water rafting, then viewed an advertisement for outdoor adventure gear, then watched a movie trailer about a wilderness hiking disaster, and finally ordered the feature movie presentation about a wilderness survival competition.

According to the present invention, when the viewer orders the feature movie presentation, the pay-per-view service prepares to send the movie along with the commercials that will precede and follow the movie. At this point, profile processor 104 analyzes the event data and additional data, classifies the viewer in a certain demographic group, and delivers a commercial targeted for that group. As an example, given the viewer's interest in outdoor adventures, a suitable advertisement would be a commercial for a sport utility vehicle with specialized accessories that carry outdoor adventure gear. The present invention would deliver this advertisement as a full screen video stream played prior to or after the showing of the feature movie presentation. [Swix column 12 lines 22 - 60.]

Column 10 line 51 to column 11 lines 1-2 of Swix states that:

During this interactive session, the navigator records each subscriber selection as event data. In the preferred embodiment, the navigator uploads the latest event data to merge processor 100 every time a new targeted advertisement must be inserted. In this manner, profile processor 100 has the latest event data, along with the data from other databases, to assess a viewer's current interests. Thus, for example, in screen 302, the present invention could display a bit map or video movie trailer advertisement enticing the subscriber to look further into the menu options but not necessarily targeting a specific customer profile or demographic group. Then, once the subscriber has chosen "movies" and moved to screen 304, the present invention could display a bit map or video advertisement for popcorn knowing that this particular subscriber has watched several movies in the last month (from the event data) and that the subscriber indicated a liking for

popcorn in a recent consumer spending survey (from survey database 126).
[Column 10 line 51 to column 11 line 2.]

The foregoing passages relied upon by the examiner to support her assertion that Swix teaches “selecting a targeted promotion from a plurality of potential promotions based upon said one or more characteristics of said consumer, said determined time being for said targeted promotion,” do not support her assertion. Furthermore, nothing in Swix discloses the limitations of claim 16.

The passage that the examiner cited in Swix is directed to classifying the viewer in a certain demographic group and delivering commercials targeted for that group. See column 6 lines 16-24. Swix discloses delivering commercials when there is an open advertisement slot. See column 9 lines 17-20. Swix further discloses delivering advertisements as a full screen video stream played prior to or after the showing of a feature movie presentation. See column 12 lines 49-50. However, Swix does not disclose determining the timing of its promotion, specifically based upon either the “parameters” defined by claim 1 or claim 16's additional limitation that the “determined timed time being for said targeted promotion.”

Because Swix does not disclose the subject matter defined by claim 16, the rejection of claim 16 is improper and should be reversed.

**h. The 35 USC 102(e) Rejections Of Claims 17 And 18 Are
Improper And Should Be Reversed**

Claims 17 and 18 are rejected under 35 USC 102(e) as being anticipated by Swix. In support of the examiner's rejection, the examiner states that:

With respect to claims 17-18, Swix further teaches selecting said targeted promotion comprises matching said one or more characteristics of said consumer to a desired consumer profile (col. 12, lines 22-60). [Office Action mailed Jan. 7, 2005 page 7 lines 10-12.]

In response, the applicants submit that for at least the reasons the rejection of claim 1 is improper, the rejections of claims 17 and 18 are improper.

Furthermore, Swix does not disclose a method wherein a “desired consumer profile originates from a promoter,” as recited by claim 18. The examiner cites to column 12 lines 22-60 for disclosing this recitation which is quoted herein above in the response to the rejection of claim 16.

The foregoing passage, cited by the examiner for her assertion that Swix discloses a consumer profile which “originates from a promoter,” does not support her assertion. A promoter is defined in the specification at page 4 lines 14-16 as any company, manufacturer, distributor, retailer, wholesaler, service provider, individual, and/or any other entity that wishes to provide promotions related to the promoter’s product and/or service to consumers. While Swix teaches that a consumer profile originates from Swix’s system, Swix does not disclose a system that provides promotions related to its own product, thus the system disclosed in Swix is not a promoter. Therefore, Swix does not teach that the consumer profile originates from a promoter. Therefore, the rejection of claim 18 is improper and should be reversed.

i. The 35 USC 102(e) Rejections of Claims 26 And 44 Are Improper And Should Be Reversed

Claims 26 and 44 are rejected under 35 USC 102(e) as being anticipated by Swix. In support of the examiner’s rejection, the examiner states that:

With respect to claims 26 and 44, Swix further teaches determining said time at which said promotion is to be provided comprises determining at least one of a demographic and a purchase characteristic of said consumer (col. 12, lines 22-60). [Office action mailed Jan. 7, 2005 page 7 lines 13-15.]

In the response to arguments section of the final office action, the examiner further asserts that:

Applicant argues that Swiss [sic] doesn't teach that the promotion is based on demographic and purchase history of the customer. The examiner disagrees with Applicant because Swiss [sic] on col. 6, lines 8-25, using the customer demographics and interactive purchasing pattern, to target promotions. [Office action mailed Jan. 7, 2005 page 10 lines 17-20.]

In reply, the applicant submits that for at least the reasons the rejection of claim 1 is improper, the rejections of claims 26 and 44 are improper.

Furthermore, Swix does not disclose either a method or a system including the step of "determining said time at which said promotion is to be provided comprises determining at least one of a demographic and a purchase history characteristic of said consumer," as recited by claim 26 and defined by claim 44. The examiner cites to Swix column 12 lines 22-60 and column 6 lines 8-25 for disclosing this recitation. Column 12 lines 22-60 of Swix was quoted herein above in the response to the rejection of claim 16.

Column 6 lines 8-25 of Swix states that:

The present invention is a system and method for providing targeted advertisements over networked media delivery systems, such as interactive media delivery systems, conventional cable television networks, wireless cable television networks, home satellite television networks, and other media delivery systems that allow duplex communication (perhaps with the return path via a separate, e.g., telephone, network) to a set-top box coupled to a subscriber's display device, such as a television. As an overview, the present invention records the viewing selections of a subscriber, compiles the viewing selection data along with other available data (e.g., interactive purchasing or questionnaire data), analyzes the data to formulate a customer profile, matches the customer profile to a demographic group, and displays for the customer a bit map or video stream advertisement that is customized for the customer or the customer's demographic group. [Column 6 lines 8-25.]

The foregoing passages, cited by the examiner for her assertion that Swix teaches a method wherein said step of determining said time at which said promotion is to be provided comprises determining at least one of a demographic and a purchase history characteristic of said consumer, do not support her assertion.

Swix teaches a system which records the subscriber's profile, classifies the customer into a demographic group and displays an advertisement to the customer that is customized for the customer or the customer's demographic group. See column 6 lines 8-25. Thus, Swix teaches determining the types of commercials to send to a consumer based upon their classified demographic group. Swix discloses that advertisements are delivered when an advertisement slot becomes available. See column 9 lines 19-20.

Swix does not disclose determining the timing of a targeted promotion based upon the demographics or purchase history of the consumer. The timing of when the advertisements are aired in Swix has nothing to do with the demographic and purchase history of the consumer. Rather, the advertisements in Swix are delivered when there is an open advertisement slot. Therefore, Swix does not disclose a method wherein said step of determining said time at which said promotion is to be provided comprises determining at least one of a demographic and a purchase history characteristic of said consumer, as defined by claims 26 and 44.

Thus, the rejections of claims 26 and 44 are improper and should be reversed.

3. The Rejections Of Claims 6, 8, 22, 37, 38, 43, And 47-58 Under 35 USC 103 As Being Obvious In View Swix Are Improper And Should Be Reversed

Claims 6, 8, 22, 37, 38, 43, and 47-58 stand rejected under 35 USC 103(a) as being unpatentable over Swix. In support of the rejections the examiner states that:

Claim 6, 22, 38 further recites that the promotions received by said consumer relate to a location where the promotions can be exercised by the consumer. Official notice is taken that it is old and well known for promotions to have a location in which it can be redeemed in order to promote patronage of an

establishment. It would have been obvious a person of ordinary skill in the art at the time of Applicant's invention to have included the promotions received by said consumer relate [sic] to a location where the promotions can be exercised by the consumer in order to obtain the above mentioned advantage.

Claims 8 and 37 further recites [sic] a promotion validity date. Official notice is taken that it is old and well known for offers to have a validity date in which the offers can be redeemed in order allow promoters/manufacture to better manage the offers. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included recites [sic] a promotion validity date in order to obtain the above mentioned advantage.

Claim 43 further recites that the promotions have a time of receipt record. Official notice is taken that it is old and well known in the computer related arts to time stamp information received in order to keep track of when the information was received. It would have been obvious to a person of ordinary skill in the art at the time [of] Applicant's invention to have included [a] promotions time receipt record in order to obtain the above mentioned advantage.

Claim 47-58 recite well known forms and methods of distributing an offer and would therefore have been obvious to one of ordinary skill in the art to use such a known form of advertisement. [Office action mailed Jan. 7, 2005 page 7 line 27to page 8 line 23; interpolation supplied.]

The examiner further states in the response to argument section:

With respect to the official notice taken by the Examiner that having a location at which to redeem an offer, for offers to have a validity date in which the offers can be redeemed, the promotions having a time stamp, Applicant asserts that Swiss does not teach, suggest, illustrate or enable with of the functions such functions and that is not valid reasoning, but this is not relevant to the use of Official Notice. While applicant may challenge the examiner's use of Official

Notice, applicant needs to provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of. See MPEP 2144.03 where in re Boon is mentioned. [Office action mailed Jan. 7, 2005 page 10 line 21 to page 11 line 6.]

In response, the applicant respectfully traverses these rejections because they are not supported by substantial evidence or valid reasoning. The rejections should be reversed for the reasons stated below.

a. **The 35 USC 103 Rejections of Claims 6, 22, And 38 Are Improper And Should Be Reversed**

As per claim 6, the examiner takes official notice that it is allegedly old and well known for a promotion to have a location in which it can be redeemed in order to promote patronage of an establishment. However, the examiner's official notice does not address the limitations of claim 6. Specifically, claim 6 defines a method of determining a time at which a promotion will be provided based upon a location where the promotion received. Neither Swix nor the examiner's official notice teach the step of "determining a time at which a promotion is to be provided," as recited in claim 6. Thus, the examiner has not presented a prima facie case of obviousness, and therefore the rejection of claim 6 should be reversed.

As per claim 22, the examiner takes official notice that it is allegedly old and well known for promotions to have a location in which it can be redeemed in order to promote patronage of an establishment. However, the examiner's official notice does not address the limitations of claim 22. Specifically, claim 22 defines a method of determining a number of promotions exercisable at a particular location that were recently received by said consumer. Neither Swix nor the examiner's official notice teach the step of "determining a number of promotions recently received by said consumer exercisable at a particular location that were recently received by said consumer," as recited in claim 22. Thus, the examiner has not presented a prima facie case of obviousness, and the rejection of claim 22 should be reversed.

As per claim 38, the examiner takes official notice that it is old and well known for

promotions to have a location in which it can be redeemed in order to promote patronage of an establishment. However, the examiner's official notice does not address the limitations of claim 38. Specifically, claim 38 defines a system wherein the received promotions record comprises a received promotion valid location code. Neither Swix nor the examiner's official notice teaches a system comprising a received promotions record for a customer that contains a "received promotion valid location record," as defined by 38. Thus, the examiner has not presented a prima facie case of obviousness, and therefore the rejection of claim 38 should be reversed.

**b. The 35 USC 103 Rejections Of Claims 8 And 37 Are Improper
And Should Be Reversed**

As per claim 8, the examiner takes official notice that it is allegedly old and well known for offers to have a validity date prior to which the offers can be redeemed in order allow promoters/manufacture to better manage the offers. However, the examiner's official notice does not address the limitations of claim 8. Specifically, claim 8 defines determining a time at which a promotion is to be provided based upon validity dates of previously provided promotions. Neither Swix nor the examiner's official notice teach the step of "determining a time at which a promotion is to be provided based upon a validity date of said promotions received," as defined by claim 8. Thus, the examiner has not presented a prima facie case of obviousness, and therefore the rejection of claim 8 should be reversed.

As per claim 37, the examiner takes official notice that it is allegedly old and well known for offers to have a validity date in which the offers can be redeemed in order allow promoters/manufacture to better manage the offers. However, the examiner's official notice does not address the limitations of claim 37. Specifically, claim 37 defines a system wherein the received promotions record comprises a received promotion validity date record. Neither Swix nor the examiner's official notice teaches a system comprising "a promotion output device configured to output a targeted promotion at a promotion time based at least in part upon said record characteristics of said consumer" and "a processor configured ...to determine said promotion time at least in part based upon said record or characteristics of said consumer contained in said consumer characteristic record" and "said received promotions record

comprises a received promotion validity date record,” as defined by claim 37. Thus, the examiner has not presented a prima facie case of obviousness, and therefore the rejection of claim 37 should be reversed.

c. The 35 USC 103 Rejection Of Claim 43 Is Improper And Should Be Reversed

As per claim 43, the examiner takes official notice that it is allegedly old and well known in the computer related arts to time stamp information received in order to keep track of when the information was received. However, the examiner’s official notice does not address the limitations of claim 43. Specifically, the examiner’s official notice does not suggest storing this data in a consumer characteristics record. Neither Swix nor the examiner’s official notice teach a system comprising “a promotion output device configured to output a targeted promotion at a promotion time based at least in part upon said record characteristics of said consumer” and “a processor configured ...to determine said promotion time at least in part based upon said record or characteristics of said consumer contained in said consumer characteristic record” and “said received promotions record comprises a received promotion time of receipt record,” as defined in claim 43. Thus, the examiner has not presented a prima facie case of obviousness, and therefore the rejection of claim 43 should be reversed.

d. The Official Notice Taken By The Examiner With Regard To Claims 6, 8, 22, 37, 38, And 43 Is Improper And The Rejections Supported Thereby Should Be Reversed For These Additional Reasons

The official notice taken by the examiner with respect to a promotion having a location in which it can be redeemed in order to promote patronage of an establishment, which is recited by claims 6, 22, and 38 is improper. The official notice taken by the examiner with respect to a promotion validity date, which is recited by claims 8 and 37, is improper. The official notice taken by the examiner with respect to time stamp information received in order to keep track of when the information was received, which is recited by claim 43, is improper.

Each reason is discussed below.

First, the applicants submit that the examiner's reliance on official notice is improper, since it forms the basis for the examiner's obviousness conclusion. See Barry, "Did You Ever Notice? Official Notice in Rejections" 81 JPTOS 129 (1999). Therefore, the rejections of claims 6, 8, 22, 37, 38, and 43 relying upon the official notice are improper and should be reversed.

Second, the examiner's reasoning for taking official notice is flawed. The applicants submit that noticing that it is old and well known: (1) "for promotions to have a location in which it can be redeemed in order to promote patronage of an establishment", "for offers to have a validity date in which the offers can be redeemed in order [to] allow promoters/manufacturers [s] to better manage the offers", and "in the computer related arts to time stamp information received in order to keep track of when the information was received" are not appropriate circumstances for reliance upon official notice. In addressing this topic, MPEP 2144.03(A) states that:

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing In re Knapp Monarch Co., 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

By taking official notice, the examiner asserts that certain facts are well-known or are common knowledge in the art and are capable of instant and unquestionable demonstration. The applicants dispute these assertions because these facts are not capable of instant and unquestionable demonstration as being well-known. Therefore, the rejections of claims 6, 8, 22, 37, 38, and 43 relying upon official notice are improper and should be reversed.

**e. There Is No Teaching In Swix Suggesting Claims 47-58;
Therefore, The Rejections Of Claims 47-58 Are Improper And
Should Be Reversed**

The rejections of claims 47-58 in view of Swix are improper for several reasons.

First, the examiner has not presented a prima facie case of obviousness. The Patent and Trademark Office has the burden of showing a prima facie case of obviousness. In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993); In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. See Burlington Industries v. Quigg, 822 F.2d 1581, 1583, 3 USPQ2d 1436, 1438 (Fed. Cir. 1987); In re Hedges, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1987); Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1013, 217 USPQ 193, 200 (Fed. Cir. 1983); In re Rinehart, 531 F.2d 1048, 1053-54, 189 USPQ 143, 148 (CCPA 1976).

The examiner has only stated that the methods of distributing the offer in claims 47-58 are well known. The examiner has not explained why it would have been obvious to modify the commercials as presented in Swix to arrive at the claimed limitations of claims 47-58. Furthermore, there is no suggestion to modify Swix to arrive at the claimed limitations of claims 47-58. Therefore, the examiner has not presented a prima facie case of obviousness to support the rejection of claims 47-58.

Second, Swix does not teach the limitations as defined by claims 47-58.

Swix does not teach a method or system of providing promotions “wherein said promotions received by said consumer is embodied in a flier,” as recited by claims 47, 51, and 55. Therefore, the rejections of claims 47, 51, and 55 are improper and should be reversed.

Swix does not teach a method or system of providing promotions “wherein said promotions received by said consumer is embodied in a newsletter,” as recited by claims 48, 52, and 56. Therefore, the rejections of claims 48, 52, and 56 are improper and should be reversed.

Swix does not teach a method or system of providing promotions “wherein said promotions received by said consumers comprises a coupon,” as recited by claims 49, 53, and 57.

Therefore, the rejections of claims 49, 53, and 57 are improper and should be reversed.

Swix does not teach a method or system of providing promotions “wherein said promotions received by said consumers is embodied in a recipe,” as recited by claims 50, 54, and 58. Therefore, the rejections of claims 50, 54, and 58 are improper and should be reversed.

f. There Is No Teaching In Swix Suggesting Claims 1, 28, And 33

The examiner has not rejected independent claims 1, 28, and 33 under 35 USC 103 as being obvious in view of Swix.

Claim 1 defines identifying one or more parameters related to promotions received by a consumer and determining a time at which a promotion is to be provided based on the identified parameter related to promotions received by the consumer. As noted above, the examiner has not presented evidence that Swix suggests these steps; and in fact, Swix does not suggest those steps. Therefore, Swix provides no basis to reject claim 1 under 35 USC 103.

Claim 28 defines a system with means for identifying one or more parameters related to promotions received by said consumer based upon said identification information received by said means for receiving; and means for determining a time at which a promotion is to be provided based upon said one or more parameters related to promotions received by said consumer, said one or more parameters identified by said means for identifying. As noted above, the examiner has not presented evidence that Swix suggests these steps; and in fact, Swix does not suggest those steps. Therefore, Swix provides no basis to reject claim 28 under 35 USC 103.

Claim 33 defines a system with a promotion output device configured to output a targeted promotion at a promotion time based in part upon record characteristics of a consumer and a processor configured to use the received consumer identification information to identify a consumer using stored consumer identification information, and determine a promotion time based upon the record characteristics of the consumer contained in the consumer characteristic record. The examiner has not presented evidence that Swix suggests these steps; and in fact, Swix does not suggest those steps. Therefore, Swix provides no basis to reject claim 33 under 35 USC 103.

H. 37 CFR 41.37 (c)(1)(viii) Claims Appendix

An appendix containing a copy of the claims involved in the appeal is attached as Appendix I.

I. 37 CFR 41.37 (c)(1)(ix) Evidence Appendix

There is no evidence submitted pursuant to 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal.

J. 37 CFR 41.37 (c)(1)(x) Related Proceedings Appendix

There are no related proceedings. Therefore, this section is inapplicable.

IV. 37 CFR 47.37 (c)(2)

This brief does not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence.

V. 37 CFR 41.37 (d)

This brief is in compliance with the requirements of paragraph (c) of this section. Accordingly, this section is inapplicable.

VI. 37 CFR 41.37 (e)

This appeal brief is filed timely. Accordingly, no extensions of time are necessary.

4/7/05
DATE

Respectfully Submitted,

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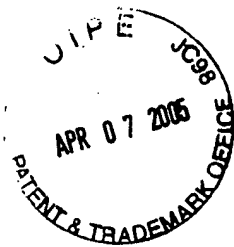
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APPENDIX I

Claim 1: A computer-implemented method comprising steps of:

receiving identification information from a consumer;
identifying, based upon said received identification information, one or more parameters related to promotions received by said consumer; and
determining a time at which a promotion is to be provided based upon said identified one or more parameters related to promotions received by said consumer.

Claim 2: The method according to claim 1, wherein said one or more parameters related to said promotions received by said consumer relate to a packaging of said received promotions received by said consumer.

Claim 3: The method according to claim 1, wherein said one or more parameters related to said promotions received by said consumer relate to a time at which said promotions received were received by said consumer.

Claim 4: The method according to claim 1, wherein said one or more parameters related to said promotions received by said consumer relate to a product class of said promotions received by said consumer.

Claim 5: The method according to claim 1, wherein said one or more parameters related to said promotions received by said consumer relate to a product industry of said promotions received by said consumer.

Claim 6: The method according to claim 1, wherein said one or more parameters related to said promotions received by said consumer relate to a location where said promotions received can be exercised by said consumer.

Claim 7: The method according to claim 1, wherein said one or more parameters related to said promotions received by said consumer relate to a value of said promotions received.

Claim 8: The method according to claim 1, wherein said one or more parameters related to promotions received by said consumer relate to a validity date of said promotions received , such that said determining is based upon at least one validity date of promotions previously received by said consumer.

Claim 9: The method according to claim 1, wherein said one or more parameters related to said promotions received by said consumer relate to a provision method of said promotions received.

Claim 10: The method according to claim 1, wherein said one or more parameters related to said promotions received by said consumer relate to a other purchases necessary to exercise said promotions received.

Claim 11: The method according to claim 1, wherein said one or more parameters related to said promotions received by said consumer relate to a nature of said promotions received.

Claim 12: The method according to claim 1, wherein said one or more parameters related to said promotions received by said consumer relate to a promoter who is the source of said promotions received.

Claim 13: The method according to claim 1, wherein said step of identifying one or more parameters comprises determining if said consumer is appropriate for said promotion, said promotion being predetermined.

Claim 14: The method according to claim 1, further comprising a step of providing said promotion at said determined time to said identified consumer.

Claim 15: The method according to claim 1, further comprising a step of using said received identification information to identify said consumer.

Claim 16: The method according to claim 1, further comprising a step of selecting a targeted promotion from a plurality of potential promotions based upon said one or more characteristics of said consumer, said determined time being for said targeted promotion.

Claim 17: The method according to claim 16, wherein said step of selecting said targeted promotion comprises matching said one or more characteristics of said consumer to a desired consumer profile.

Claim 18: The method according to claim 17, wherein said desired consumer profile originates from a promoter.

Claim 19: The method according to claim 1, further comprising a step of receiving a predetermined promotion from a promoter, said determined time being for said predetermined promotion.

Claim 20: The method according to claim 1, wherein said step of determining said time at which said promotion is to be provided comprises determining a number of promotions recently received by said consumer.

Claim 21: The method according to claim 20, wherein said number of promotions recently received by said consumer comprises promotions in a particular industry that were recently received by said consumer.

Claim 22: The method according to claim 20, wherein said number of promotions recently received by said consumer comprises promotions exercisable at a particular location that were recently received by said consumer.

Claim 23: The method according to claim 1, wherein said step of determining said time at which said promotion is to be provided comprises determining a value of said promotions recently received by said consumer.

Claim 24: The method according to claim 1, wherein said step of determining said time at which said promotion is to be provided comprises determining an importance of said provision of said promotion to a promoter.

Claim 25: The method according to claim 24, further comprising charging a promoter according to said importance of said provision of said promotion.

Claim 26: The method according to claim 1, wherein said step of determining said time at which said promotion is to be provided comprises determining at least one of a demographic and a purchase history characteristic of said consumer.

Claim 27: The method according to claim 1, wherein said step of determining said time at which said promotion is to be provided comprises:

- determining promotions recently received by said consumer;

- determining at least one of a demographic and a purchase history characteristic of said consumer;

- determining an importance of said provision of said promotion to a promoter; and

- fusing said determined promotions recently received, said at least one of a demographic and a purchase history characteristic, and said importance of said provision into one parameter related to said time at which said promotion is to be provided.

Claim 28: A system, comprising:

- means for receiving identification information from a consumer;

- means for identifying one or more parameters related to promotions received by said consumer based upon said identification information received by said means for receiving; and

means for determining a time at which a promotion is to be provided based upon said one or more parameters related to promotions received by said consumer, said one or more parameters identified by said means for identifying.

Claim 29: The system according to claim 28, wherein said one or more parameters of related to promotions received by said consumer comprising at least one of a timing, an industry, a class, a type, a packaging, a validity date, a valid location, other products that must be purchased to exercise, and a value of said promotions received by said consumer.

Claim 30: The system according to claim 28, further comprising means for providing said promotion at said time determined by said means for determining to said consumer identified by said means for identifying.

Claim 31: The system according to claim 28, further comprising means for selecting a targeted promotion from a plurality of potential promotions based upon said one or more characteristics of said consumer, said time determined by said means for determining being for said targeted promotion

Claim 32: The system according to claim 28, further comprising means for receiving a predetermined promotion from a promoter, said time determined by said means for determining being for said predetermined promotion.

Claim 33: A system, comprising:

- a consumer identification information receiver configured to receive consumer identification information;

- a consumer identification record configured to contain stored consumer identification information;

- a consumer characteristic record configured to contain a record of characteristics of said consumer;

a promotion output device configured to output a targeted promotion at a promotion time based at least in part upon said record of characteristics of said consumer; and

a processor configured to use said received consumer identification information to identify a consumer using said stored consumer identification information, and moreover to determine said promotion time at least in part based upon said record of characteristics of said consumer contained in said consumer characteristic record.

Claim 34: The system according to claim 33, wherein:

said promotion output device comprises a network interface; and
said promotion comprises an electronic signal.

Claim 35: The system according to claim 33, wherein said consumer characteristic record comprises:

a received promotions record configured to contain a record related to received promotions received by said consumer.

Claim 36: The system according to claim 35, wherein said received promotions record comprises a received promotion value record.

Claim 37: The system according to claim 35, wherein said received promotions record comprises a received promotion validity date record.

Claim 38: The system according to claim 35, wherein said received promotions record comprises a received promotion valid location record.

Claim 39: The system according to claim 35, wherein said received promotions record comprises a received promotion product class record.

Claim 40: The system according to claim 35, wherein said received promotions record

comprises a received promotion industry record.

Claim 41: The system according to claim 35, wherein said received promotions record comprises a received promotion provision method record.

Claim 42: The system according to claim 35, wherein said received promotions record comprises a received promotion packaging record.

Claim 43: The system according to claim 35, wherein said received promotions record comprises a received promotion time of receipt record.

Claim 44: The system according to claim 33, wherein said processor is further configured to select said targeted promotion from a plurality of potential promotions based upon said one or more characteristics of said consumer.

Claim 45: The system according to claim 33, further comprising a promotion receiver configured to receive a predetermined promotion from a promoter, said promotion time determined by said processor being for said predetermined promotion.

Claim 46: A computer readable medium containing program instructions for execution on a computer system, which when executed by the computer system, cause the computer system to perform the method recited in any one of claims 1 to 27.

Claim 47: The method according to claim 1, wherein said promotions received by said consumer is embodied in a flier.

Claim 48: The method according to claim 1, wherein said promotions received by said consumer is embodied in a newsletter.

Claim 49: The method according to claim 1, wherein said promotions received by said consumers comprises a coupon.

Claim 50: The method according to claim 1, wherein said promotions received by said consumers is embodied in a recipe.

Claim 51: The system according to claim 28, wherein said promotions received by said consumer is embodied in a flier.

Claim 52: The system according to claim 28, wherein said promotions received by said consumer is embodied in a newsletter.

Claim 53: The system according to claim 28, wherein said promotions received by said consumer comprises a coupon.

Claim 54: The system according to claim 28, wherein said promotions received by said consumer is embodied in a recipe.

Claim 55: The system according to claim 33, wherein said targeted promotion is embodied in a flier.

Claim 56: The system according to claim 33, wherein said targeted promotion is embodied in a newsletter.

Claim 57: The system according to claim 33, wherein said targeted promotion comprises a coupon.

Claim 58: The system according to claim 33, wherein said targeted promotion is embodied in a recipe.

Claim 59: A computer-implemented method, comprising:

receiving identification information from a consumer at a vendor location site, comprising a vendor terminal, wherein said vendor terminal is located at a check-out counter in a store;

identifying, based upon said received identification information, one or more parameters related to promotions received by said consumer; and

determining a time at which a promotion is to be provided based upon said identified one or more parameters related to promotions received by said consumer.

Claim 60: A system, comprising:

means for receiving identification information from a consumer at a vendor location site, which comprises a vendor terminal, wherein said vendor terminal is located at a check-out counter in a store;

means for identifying one or more parameters related to promotions received by said consumer based upon said identification information received by said means for receiving; and

means for determining a time at which a promotion is to be provided based upon said one or more parameters related to promotions received by said consumer, said one or more parameters identified by said means for identifying.

Claim 61: A system, comprising:

a consumer identification information receiver at a vendor location site configured to receive consumer identification information from a consumer, wherein said vendor location site is a check-out counter in a store;

a consumer identification record configured to contain stored consumer identification information of said consumer;

a consumer characteristic record configured to contain a record of characteristics of said consumer;

a promotion output device configured to output a targeted promotion at a promotion time based at least in part upon said record of characteristics of said consumer; and

a processor configured to use said received consumer identification information to identify a consumer record using said stored consumer identification information, and to determine said promotion time at least in part based upon said record of characteristics of said consumer contained in said consumer characteristic record.

Claim 62: The method of claim 1, wherein said identifying comprises identifying in a computer system.

Claim 63: The method of claim 1, wherein said determining a time at which a promotion is to be provided based upon said identified one or more parameters related to promotions received by said consumer comprises determining in a computer system.

Claim 64: The system of claim 28, wherein said means for identifying one or more parameters related to promotions received by said consumer based upon said identification information received by said means for receiving comprises means for identifying by a digital processor.

Claim 65: The system of claim 28, wherein said means for determining a time at which a promotion is to be provided based upon said one or more parameters related to promotions received by said consumer, said one or more parameters identified by said means for identifying comprises means for determining by a digital processor.